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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,353	07/27/2001	Francis Pruche	010830-119	6986

7590 12/04/2002

Norman H. Stepno, Esquire
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER	
BAHAR, MOJDEH	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/915,353	Applicant(s) PRUCHE ET AL.	
	Examiner Mojdeh Bahar	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 September 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,27-34 and 45-47* is/are pending in the application.

4a) Of the above claim(s) *46 and 47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25,27-34 and 45-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's response to the first office action of May 8, 2002, submitted September 6, 2002 are acknowledged. Applicant's remarks and amendment is persuasive to overcome the rejections under 35 USC 101 and 112 in the previous office action.

Newly submitted claims 46-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they include a second active, i.e., a glucosidase activator, in the composition useful in the method claims herein. These second actives have a different mode of operation/function than the glucosylated hydroxystilbene compounds employed in the method claims herein.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 46-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims 46-47 drawn to an invention non-elected with traverse in Paper No. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 21-25, 27-34 and 45 are herein examined on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-25, 27-34 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. (WO 99/04747) and Waterhouse et al.

Carson et al. (WO 99/04747) teaches that resveratrol, a phytoestrogen present in red grapes, is useful in methods of inhibiting the proliferation of keratinocytes and stimulating their differentiation, improving the appearance of wrinkled, lined, dry, flaky, aged or photodamaged skin, improving skin thickness, elasticity, flexibility, radiance, glow and plumpness, see in particular abstract and claims 3-4. Carson et al. (WO 99/04747) also teaches that cosmetic compositions containing grape extract are known in the art, see in particular page 4 lines 23-33.

Waterhouse et al. teaches that both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside) are present in grape extract (i.e., Vitis species) as well as in Polygunum cuspidatum root, see in particular page 571.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ grape extract in Carson et al.'s methods of treating and/or improving skin conditions.

One of ordinary skill in the art would have been motivated to employ grape extract in Carson et al.'s methods of treating and improving skin because grape extract is known to contain both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside), known to be useful in cosmetic compositions.

Response to Arguments

Applicant's arguments filed September 6, 2002 have been fully considered but they are not persuasive.

Applicant first argues that Carson et al. only teaches the employment of resveratrol, and does not teach the employment of grape extracts in its method. Note that Carson et al. teaches the employment of grape extract in cosmetic compositions, see page 4, line 23-33. The Skilled Artisan in possession of the teachings of Carson et al., knows about the effects of resveratrol on skin as well as the fact that grape extract (a source of resveratrol) is known to be useful in cosmetic skin compositions. Applicant then argues that Carson et al. is silent as to the employment of glucosylated resveratrol in its method. Note that the invention is rendered obvious by the combination of the prior art references employed herein above, not over Carson et al. alone.

Applicant then argues against the Waterhouse et al. reference. noting that not all the different types of grapes tested had the same amounts of piceid and/or resveratrol. Note that the claims herein are not limited to any specific grape kind. Applicant then argues that this references addresses the role of glucosylated resveratrol in the context of other diseases. Note that this reference has been cited for its teaching that glucosylated resveratrol/resveratrol are known to be found in grape extracts.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant finally argues that it is not applicant's intention to apply non-glucosylated form of resveratrol in his invention, rather it is applicant's intention to use the glucosylated form in its methods. Note that the claims herein are not limited to the glucosylated form. The compositions useful in the methods herein **comprise** of at least one glucosylated hydroxystilbene. Therefore

they can contain other actives (e.g., non- glucosylated hydroxystilbene) in addition to the glucosylated hydroxystilbene.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 on Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner

SREENI PADMANABHAN
PRIMARY EXAMINER
12/1/12

November 29, 2002